

**REMARKS**

Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84 and 86-153 are pending in this application, and all stand rejected except claims 1 and 17, as well as claims depending therefrom, which have been indicated as allowable. Claims 1, 12, 17, 28 and 29 have been amended herein. No new matter has been added by this paper.

The outstanding Office Action objects to claims 2, 3 and 10 for failing to further limit the subject matter of the claim from which they depend. The Office Action cautions that use of two trademarks/names (Morton EFM-2E02 and Admer QB510A) are not defined and should be accompanied by generic terminology. All pending claims also stand rejected under 35 U.S.C. §112, ¶1 because Applicants amendment to the specification at page 2, lines 9 and 18 identifying Morton EFM-2E02 as a maleic anhydride is deemed by the Office as new matter. All pending claims also stand rejected under 35 U.S.C. §103 as unpatentable over Statutory Invention Registration H1419 to Wilpers et al. ("Wilpers"), but indicates the subject matter of claims 1 and 17 as "allowed." Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84, 86-98 and 127-53 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-52 of U.S. Patent No. 6,677,013. Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84, 86-98 and 127-53 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 21-41 of copending U.S. Patent Application Serial No. <sup>10</sup>/607,654.

**I. SPECIFICATION – OBJECTIONS AND REJECTIONS PURSUANT TO 35 U.S.C. §112, ¶1**

The outstanding Office Action objects to claims 2, 3 and 10 for failing to further limit the subject matter of the claim from which they depend. Claim one has been modified to obviate this objection.

The Office Action also cautions that use of two trademarks/names (Morton EFM-2E02 and Admer QB510A) are not defined and should be accompanied by generic terminology. Applicants previously amended the specification to identify Morton EFM-2E02 adhesive as a maleic anhydride in an attempt to overcome this objection. The outstanding rejection rejects the pending claims under 35 U.S.C. §112, ¶1 asserting that the amendment to the specification identifying Morton EFM-2E02 adhesive as a maleic anhydride added new matter.

Applicants have herein removed from the specification the identification of Morton EFM-2E02 as a maleic anhydride and assert that the entire specification is proper, including the references to Morton EFM-2E02 and ADMER QB510A. First, both Morton EFM-2E02 and ADMER QB510A are identified in the specification as a trademark of their respective manufacturers.

Second, Applicants assert that each identified adhesive has a fixed and definite meaning such that those skilled in the art at the filing date of this application could practice the invention described. Applicants respectfully assert that the specification is therefore sufficient. On information and belief, resin manufacturers such as Morton International (now Rohm & Haas) and Mitsui do not change the compositions of products once they are provided with a name such

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as EFM-2E02 or Admer 510A in order to prevent possible confusion on the part of their customers. Instead, those manufactures, on information and belief, simply provide new product names or extensions (e.g. 510A) to new products and retire the old names or extensions if rendered obsolete. Accordingly, one of ordinary skill in the art would have been able to obtain Morton EFM-2E02 and Admer 510A and practice the invention described in the specification from the information there provided. Nothing more is required. The requirements of M.P.E.P. 608.01(v) are designed to prevent the use of amorphous terms which would permit the meaning of the specification to change over time. The goal is definiteness. That goal is here met since, on information and belief, Morton and Mitsui do not change the compositions sold under their tradenames such as Morton EFM-2E02 and Admer 510A.

Where the products identified in the specification “were on the market and were known generally to those skilled in the art...at the time the original application was filed,” it was “possible for those skilled in the art at that time to practice [Applicants’] invention, and thus it follows that **the disclosure therein was sufficient.**” *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 U.S.P.Q. 125, (CCPA 1941)(*Emphasis added*). *See, also*, M.P.E.P. 608.01(v). The Manual of Patent Examining Procedure confirms this, stating “the use of trademarks having definite meanings is permissible in patent applications.” M.P.E.P. 608.01(v).

For these reasons, Applicants respectfully assert that the specification is proper and request the withdrawal of the outstanding objections and rejections based thereon.

## **II. REJECTIONS PURSUANT TO 35 U.S.C. §103**

All pending claims also stand rejected under 35 U.S.C. §103 as unpatentable over Statutory Invention Registration H1419 to Wilpers et al. ("Wilpers"), but indicates the subject matter of claims 1 and 17 as "allowed." Applicants have cancelled all claims except 1-3, 5-19 and 20-32 to expedite allowance of those claims. Applicants reserve the right to prosecute those claims in one or more continuation applications.

## **III. OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84, 86-98 and 127-53 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-52 of U.S. Patent No. 6,677,013. Applicants submit herewith a terminal disclaimer to overcome this rejection. Submission of a terminal disclaimer is not an admission that Applicants agree that the pending claims are obvious over claims 1-52 of U.S. Patent No. 6,677,013.

Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84, 86-98 and 127-53 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 21-41 of copending U.S. Patent Application Serial No. <sup>10</sup>/607,654. Applicants state no terminal disclaimer over claims 21-41 of copending U.S. Patent Application Serial No. <sup>10</sup>/607,654 is necessary since claims 21-41 have not yet issued.

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**CONCLUSION**

Applicants submit that this application is in condition for allowance. Early action to that end is respectfully requested.

Respectfully submitted,

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